

Appl. No. : 10/603,498
Filed : June 24, 2003

REMARKS

In the Office Action, the Examiner rejected all pending claims, namely Claims 1-28, based on U.S. Patent Application 2004/0022311 (hereinafter the Zerbe reference). The Applicants thank the Examiner for the detailed action and his effort to date.

In response to the Applicants' last Response, the Examiner issued a final Office Action and did not find the remarks and declarations of the inventors sufficient to establish an invention date prior to the Zerbe reference. In particular, the Examiner's only objection, in the most recent Office Action, was a lack of showing of diligence between the dates of 07 June, 2002, and 07 November, 2002. Applicants acknowledge the Examiner's concerns in that the Declaration and Exhibits filed with the prior response did not specifically detail Applicants' diligence during this time period.

In response, the Applicants submit herewith an Affidavit under 37 C.F.R. § 1.132 of the Applicants' attorney with supporting Exhibits. The comments, affidavits, and exhibits from the prior response are incorporated herein. The Applicants submit that the dates at issue are from 07 June 2002 to 07 November 2002.

The Applicants submit that during this period the patent application was being prepared by the Applicants' attorney with help from the Applicants. Reasonable diligence exercised during this period and support for this assertion is provided in the attached Affidavit of Chad W. Miller with Exhibits A-I. Before providing argument in support of the Affidavit submitted herewith, Applicants have provided a discussion of the law surrounding this analysis and to aid in interpreting the 'reasonable diligence' standard.

Appl. No. : 10/603,498
Filed : June 24, 2003

Reasonable Diligence Standard

The courts and MPEP have set forth the standards to require that the inventors show reasonable diligence in reducing the invention to practice from before the effective prior art date to the date in which the invention was reduced to practice, which may be constructive or effective. (see MPEP 715.07 and Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., 166 F.2d 288 (1st Cir. 1909).). Of particular importance is that the law requires only 'reasonable' diligence by the inventors. Hence, in view of the day to day business reality, obligations of the inventors and inventors' patent attorney and other realities of day to day life, the inventors and their attorney's actions or activities must be reasonable.

This interpretation of the reasonable diligence standard is supported by the case law in the area, some of which is cited in the MPEP. For example, it is well established that the reasonableness relates to 'attorney-diligence' and 'engineering-diligence' which does not require that "an inventor or his attorney drop all other work and concentrate on the particular invention involved." (see Emery v. Ronden 188 USPQ 264, 268 (Bd. Pat. Inter. 1974). Hence, in the present case, neither the attorney, nor the Applicants need drop all their other work, but instead need only complete the drafting and review of the patent application in a reasonable amount of time. Likewise, the inventor (and likely their attorneys) need not have taken the most expeditious course. (See Justus v. Appenzeller, 177 USPQ 322, 340 (Bd. Pat. Inter. 1971). (Note that under MPEP 715.07, page 700-251, that reasonable diligence and reduction to practice have the same meaning under 37 C.F.R. 1.131 as they have in interference proceedings.)

Applicants acknowledge that MPEP section 2138.06 discusses the reasonable diligence standard, but based on the research of the full body of case law on this topic, the Applicants submit that the MPEP does not accurately portray the reasonableness standard. This MPEP section gives the impression that the reasonableness standard is more difficult to meet than is

Appl. No. : 10/603,498
Filed : June 24, 2003

gained by reading the full body of case law, and reading the cases of the courts and Patent Appeal Board.

For example, in Mycogen Plant Services, Inc. v. Monsanto Co., 252 F.3d 1306 (Fed. Cir. 2001), the Federal Circuit held that proof of reasonable diligence does not require that a party to work constantly on the invention or to drop all other work. This view is further supported by the following passage cited by the Federal Circuit in Hybritech, Inc. V. Abbott Laboratories, 4 USPQ2d 1001, 1006 (C.D. Calif. 1987), affirmed at 849 F.2d 1446 (Fed. Cir. 1988):

[I]t is not necessary that an inventor be working on the invention every day. The question of diligence is considered in light of all the circumstances. For example, people may be sick or even take vacation (thereby creating gaps in activity) while still being diligent. . . . The question is whether they were pursuing their goal in a reasonable fashion. If they were doing the things reasonably necessary to reduce the idea to practice, then they were diligent even if they did not actually work on the invention each day.

Moreover, in De Solms v Schoenwald, 15 USPQ.2d 1507, 1511 (Bd. Pat. App. & Int’f 1990), the Board provided more insight into the reasonableness standard by stating:

It is a principle of diligence that consideration must be given to the circumstances of the inventor, including his skill and available time, and that the inventor may avail himself of the activities of others. . . [I]t is not material to the question of diligence that the inventor did not take the most expeditious course, so long as there was diligent activity toward the end in view.

The Applicants assert that this standard applies to both the applicant and applicant’s attorney.

Working from these principles regarding the reasonable diligence standards, Applicants’ attorney has submitted his Affidavit with attached Exhibits. In the Affidavit, the Applicants’ attorney has provided evidence that from June 7, 2002 to November 7, 2002 the Applicants’ attorney was engaged in drafting the patent application continuously and systematically, on an

Appl. No. : 10/603,498
Filed : June 24, 2003

almost everyday basis. Any delays are submitted as reasonable, such as vacation, awaiting input from the inventors regarding a technical point, or working on other time sensitive projects.

Applicants' Review Period

After the drafting of the patent application, the patent application was forwarded to the Applicants for review or revision. This was a substantial job. The draft patent application, which was sent to the inventors for review was 40 pages long and included 11 pages of figures, and 48 claims. All aspects of the application needed to be reviewed by the inventors. In addition, the application required substantial revisions by the Applicants due to errors that arose from the complex subject matter of the invention. In addition, the Applicants were asked to supplement the application with additional subject matter regarding the more complex subject matter. As a result, a substantial amount of work needed to be done to the draft sent to the inventors. This is discussed in greater detail in the attached Affidavit.

Delays Resulting From Applicants Attorney Workload

In addition to reviewing the draft provisional patent application, the Applicants had to research, verifying and correct the concepts as set forth in the patent application. In support of this as set forth in the Affidavit, numerous additional telephone conferences occurred between the Applicants and Applicants' attorney to discuss aspects of the invention. Additional delays by the Applicants may have resulted from the work load of the patent attorney in returning calls from the inventors and scheduling of conference calls regarding changes to the draft provisional application. The work load of the patent attorney and inventors, during the inventor review period, caused delays in returning calls and scheduling conferences. Such delays by the Applicants' attorney are reasonable, as previously detailed and supported by the applicable case law. For example, as set forth by the courts:

Appl. No. : 10/603,498
Filed : June 24, 2003

It is not necessary that an inventor or his attorney should drop all other work and concentrate on the particular invention involved. If the attorney has a reasonable backlog of work which he takes up in chronological order and carries out expeditiously, that is sufficient. See Gould v. Schawlow, 363 F.2d 908, 916 (CCPA 1966) as cited by Mycongen (2002) citing and Rines v. Morgan, 250 F.2d 365, 369 (CCPA 1957)

As discussed in the Affidavit of Chad W. Miller, the costs incurred during the period of September 1, 2002 to November 4th, 2002 and the time entries during this period provide evidence of the work load of the Applicants' attorney. Activities performed by Applicants' attorney that delayed the inventors review of the application and which are from a reasonable backlog of work, which was approached in a chronological order, are excused.

Delays resulting from Related Applications

Likewise, during the time window, Applicants' attorney was working on numerous other patent applications that related to Applicants' invention, namely a high speed data communication device that utilized signal cancellation and echo cancellation. During this period, as set forth in the Affidavit and Exhibits A-I, the Applicants' attorney and Applicants were diligently working on numerous patent applications for Applicants' company, owner of the present application. The subject matter of these other applications is related to and overlaps with the subject matter of the present application.

Any delay resulting from work on these applications, by the Applicants and the Applicants' attorney, is excused based on the existing case law and rules. For example, in Bey v. Kollonitsch, 806 F.2d 1024 (Fed. Cir. 1986) the court held that that sufficient diligence was established when a single attorney worked diligently on a group of patent applications relating to the same subject matter event though no priority was given to any particular application.

Appl. No. : 10/603,498
Filed : June 24, 2003

Likewise, in Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Int'f 1989) the Appeals Board held that reasonable diligence was shown when it was shown that:

[T]he inventors and their attorney worked diligently during the relative time period on a series of closely related patent application including the one at issue.

Based on this case law, any delay caused by the work on the other related patent applications should be excused, and such work on related applications should work to the benefit of the Applicants. As shown in the Exhibits and discussed in the attached Affidavit, substantial work was performed by all parties on the related applications during the relevant time period. These applications are related because all applications worked on during this period and owned by the assignee Solarflare are directed to the same inventive concept, namely, high speed signal processing to reduce interference and echo in a 10 Gigabit communication device.

SUMMARY

Applicants assert that given the length, complexity, and number of corrections that needed to be made to the patent application, in addition to the steps of verifying, such as in the lab, the accuracy of the draft, the Applicants acted with reasonable diligence, in connection with their attorney, in completing and filing the draft during the period of June 7, 2002 to November 7, 2002.

By inventing prior to July 12, 2002, and providing sufficient proof of such invention and diligently working on the invention and application until the filing date of November 7, 2002, the Applicants submit that the Zerbe reference does not qualify as prior art and the rejection based on the Zerbe reference should be withdrawn.

Appl. No. : 10/603,498
Filed : June 24, 2003

Applicants submit that no other prior art references were cited in the most recent Office Action and as such, Applicants believe the claims of the present application are now in condition for allowance. The Applicants have taken no action, such as claim amendments, that would necessitate another search. Applicant asserts that Claims 1-28 are in a condition for allowance and respectfully requests a notice as to the same. If any matters remain outstanding, the Examiner is invited to contact the undersigned by telephone.

Dated: _____

4/12/06

By: _____

Respectfully submitted,

C. Miller

Chad W. Miller
Registration No. 44,943
Weide & Miller, Ltd.
Bank West Building, 5th Floor
7251 West Lake Mead Blvd., Suite 530
Las Vegas, NV 89128
(702)-382-4804 (Pacific time)